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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,045	12/07/2000	Andrew Paul Chapman	CARP-0086	3379

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EXAMINER

SAUNDERS, DAVID A

ART UNIT PAPER NUMBER

1644

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/719,045

Applicant(s)

CHAPMAN ET AL.

Examiner

David A. Saunders, PhD

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 24 September 2004. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 112, 2nd.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: NONE.
Claim(s) objected to: NONE.
Claim(s) rejected: 1-7 and 10-15.
Claim(s) withdrawn from consideration: 8 and 9.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____

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The amendment will not be entered, since further consideration of the references cited would be required. It appears that the amendment was filed to overcome the prior art and not to overcome 112, 1st or 2nd issues (see response at page 11).

The 112, 2nd rejection is withdrawn. Examiner concurs that the claim reads such that the increased half-life is in comparison to the divalent antibody fragment sans the polymer.

The 112, 1st new matter rejection is maintained. That the claims now read that the increased half-life is in comparison to the divalent antibody fragment sans the polymer, whereas the original disclosure taught that the increased half-life is in comparison to the divalent antibody with the polymer randomly attached polymer, is indicative of a change in the nature of the claimed invention. The examiner has only the time to evaluate the passages pointed to by applicant for support in his response to the first action and in the passages, which summarized the invention in the original disclosure. Applicant has presented a lengthy after FINAL response, which would require the examiner to compare and contrast numerous passages, Tables, and Figures in the original disclosure. This would require more than

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a cursory review, which is all that is required on the part of the examiner after FINAL.

The 112, 1st written description rejection is maintained. Applicant has likewise pointed to more passages, Tables, and Figures than the examiner has time to consider after FINAL. Applicant has concluded by arguing that “it is not the type of polymer that is important, but that there is a polymer.” See page 11. The examiner notes that he did examine the claims on the basis of the simple fact that there is a polymer, in the first action; and, from the way the claims were then recited, the examiner had no need to state a written description rejection. Applicant then amended the claims to add a functional feature resulting from the addition of the polymer, and applicant has failed to tie any structural features of the polymer to this added functional limitation. Applicant’s response to the first action has created highly complex problems that the examiner does not have time to fix after FINAL.

The prior art rejections are maintained. As noted supra, it appears that the amendment, if entered, would require reconsideration of the references. Even if amendment entry, per se, did not require the reconsideration, the examiner finds applicant’s arguments present more than can be considered

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after FINAL. A cursory review of applicant's arguments shows applicant is arguing at least one point in an erroneous manner. Example:) At page 13 applicant argues that Gonzales et al are not teaching divalent fragments but, rather, monvalent fragments, such as Fab, Fab', Fab'-SH. As the examiner pointed out (action of 3/24/04 at page 6) two or more of these are coupled to a polymer; this coupling certainly would create a conjugate that is divalent or even oligovalent. The examiner does not have the time after FINAL to address other points of applicant's arguments concerning the prior art; however since one point has been shown to be erroneous, the prior art rejection has not been overcome. Further, the examiner has already been required to examine the prior art twice, because of the change in the nature of the claimed invention presented by applicant, in response to the first action. Due to the increased burden upon the examiner in preparing the second action, the examiner will not fix applicant's problems after final.

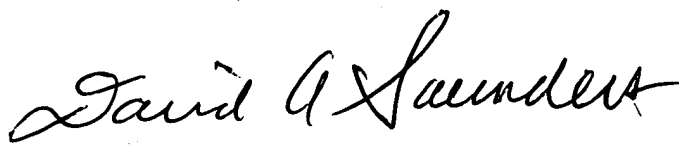
Claims 8-9 will not be rejoined, since no generic claim is allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Saunders, PhD whose telephone number is 571-272-0849. If attempts to

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reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DAVID SAUNDERS
PRIMARY EXAMINER
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